



07-11-5

PATENT APPLICATION

ATTORNEY DOCKET NO. 10004991-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Thomas D. Benson

Confirmation No.: 8164

Application No.: 10/004,296

Examiner: J.A. Fischetti

Filing Date: 10/31/2001

Group Art Unit: 3627

Title: AUTOMATED SYSTEM FOR AND METHOD OF INVENTORY MANAGEMENT CONTROL

Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

<input type="checkbox"/> Response/Amendment	<input type="checkbox"/> Petition to extend time to respond
<input type="checkbox"/> New fee as calculated below	<input type="checkbox"/> Supplemental Declaration
<input type="checkbox"/> No additional fee	
<input checked="" type="checkbox"/> Other: Petition of Restriction Requirement	(fee \$ <u>130.00</u> )

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	9	MINUS	29	= 0	X \$50	\$ 0
INDEP. CLAIMS	2	MINUS	5	= 0	X \$200	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1590.00		\$ 0
OTHER FEES						\$ 130
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 130

Charge \$ 130 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

"Express Mail" label no. EV482707880US

Respectfully submitted,

Thomas D. Benson

By Michael J. Fogarty, III

Michael J. Fogarty, III

Attorney/Agent for Applicant(s)  
Reg. No. 42,541

I hereby certify that this is being deposited with the  
United States Postal Service "Express Mail Post  
Office to Addressee" service under 37 CFR 1.10 on  
the date indicated above and is addressed to:  
Commissioner for Patents, Alexandria, VA  
22313-1450.

By Robert L. Greeson

Typed Name: Robert L. Greeson

Date: 07/08/2005

Telephone No.: (214) 855-8172

- Attach as First Page to Transmitted Papers -



JUL 08 2005

Application No.: 10/004,296

Attorney Docket No.: 10004991-1

## Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV482707880US in an envelope addressed to:

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on July 8, 2005  
Date



Signature

Robert L. Greeson

Typed or printed name of person signing Certificate

52,966  
Registration Number, if applicable

(214) 855-7430  
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Return Postcards (2)  
Certificate of Express Mailing (1 page)  
Transmittal (2 pages, 1 original and 1 copy)  
Petition (4 pages)



Application No.: 10/004,296

Docket No.: DO-047607/P330US/10024589

Docket No.: 10004991-1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas D. Benson

Application No.: 10/004,296

Confirmation No.: 8164

Filed: October 31, 2001

Art Unit: 3627

For: AUTOMATED SYSTEM FOR AND METHOD  
OF INVENTORY MANAGEMENT CONTROL

Examiner: J. A. Fischetti

**PETITION OF RESTRICTION REQUIREMENT PURSUANT TO 37 C.F.R. § 1.144**

MS Petitions  
P.O. Box 1450  
Alexandria, VA 22313-1450

**BRIEF SUMMARY OF ACTIONS**

The present application was filed on October 31, 2001 having claims 1-20. A First Office Action was mailed on February 13, 2004, which rejected claims 8-14 and withdrew claims 1-7 and 15-20 from consideration based upon a restriction requirement. In response to the First Office Action, claims 1-7 and 15-20 were withdrawn, new claims 21-29 were added, and claims 8-14 were elected for prosecution.

A Second Office Action was mailed on August 20, 2004, which again rejected claims 8-14 and withdrew claims 21-29 based upon another restriction requirement. Specifically, the Examiner asserted new claims 21-29 were directed to an independent or distinct invention from that invention originally claimed. The Examiner also asserted that the elected group (claims 8-14) was drawn to a method and claims 21-29 were directed to a device/code. The Examiner further asserted that claims 8-14 had been constructively elected by original presentation for prosecution on the merits. In Response to the Second Office Action, the Applicant traversed the finality of the Second Office Action, traversed the rejections of claims 8-14, and traversed the restriction of claims 21-29.

A Third Office Action (the “Advisory Action”) was mailed on November 10, 2004, which reiterated the Examiner’s position that claims 8-14 stood rejected and claims 21-29 were withdrawn from prosecution by restriction. On January 19, 2005, the Applicant filed a Request for Continued Examination and a Preliminary Amendment canceling claims 1-20 and leaving claims 21-29 pending as previously presented.

A Fourth Office Action was mailed on April 7, 2005, which rejected claims 21-24 and withdrew claims 25-29 based upon yet another restriction requirement. Specifically, the Examiner asserted the invention of claims 21-24 and the invention of claims 25-29 are subcombinations useable together. The Examiner also asserted that the Applicant elected a group of claims (claims 8-14) drawn to an embodiment having a claim limitation not embodied in claims 25-29.

In the Fourth Office Action, the Examiner issued an inappropriate restriction requirement, and, the Applicant has distinctly and specifically pointed out the errors in that restriction requirement and requested reconsideration of the requirement. In the interest of speeding prosecution, the Applicant respectfully requests that the Fourth Office Action’s restriction be removed pursuant to 37 C.F.R. § 1.144.

#### REMARKS

The Fourth Office Action concluded that claims 25-29 are drawn to a non-elected invention, and, as a result, withdrew them from consideration. Also, the Fourth Office Action concluded that claims 21-24 had been constructively elected. At page 2, the Fourth Office Action states:

On 1/30/04 applicant elected claims 8-14 which were drawn to the embodiment of receiving a single confirmation message from the supplier, which claim limitation is only embodied in claims 21, but not embodied in claim 25....Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

As discussed above, claims 1-20 have been cancelled. Therefore, the Applicant respectfully points out that any comparison between claims 8-14 and claims 21-29, for purpose restriction, is inappropriate.

37 C.F.R. 1.145, cited by the Examiner, reads in pertinent part:

If, after an office action on the application, the applicant present claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered...

The Applicant is no longer asserting claims 8-14. As such, the determination of whether the invention embodied in claims 21-29 is distinct from, and independent of, the invention embodied in claims 8-14 is irrelevant.

Moreover, the Applicant respectfully asserts that on its face the restriction requirement of the Fourth Office Action is improper. At page 2, the Fourth Office Action states:

Newly submitted claims 25-29 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons: claims 21-24 are drawn to a subcombination covering a single confirmation step in combination with a feedback re-determining quantity step whereas claims 25-29 are drawn to a dual confirmation request step method in combination with a single step quantity determination step. As such, the claims are subcombinations useable together.

The Applicant respectfully points out that there are two criteria for a proper requirement for restriction: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. Further, such a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search. *See* M.P.E.P. § 808.02. The Applicant respectfully points out that the Fourth Office Action makes no showing at all of a burden on the patent office. Without such a showing the restriction requirement is improper, and the Applicant respectfully asks that the restriction be withdrawn.

In addition, the Applicant respectfully asserts that the Examiner's own characterization would preclude restriction. As mentioned above, the Fourth Office Action contends that restriction is appropriate because claims 21-24 and claims 25-29 are "subcombinations useable together." (Fourth Office Action, pg 2). The Applicant respectfully submits that the Examiner's characterization of the claims is incorrect.

Nevertheless, even if the Examiner's characterization of the claims could be supported, the Examiner's own description proves that restriction between the claimed groups is inappropriate. The Examiner describes claim 21 as comprising a "single confirmation step" and claim 25 as comprising a "dual confirmation step." (Fourth Office Action, pg. 2). Thus, as characterized by the Examiner, claim 21 would cover a single, dual, or multiple confirmation step, and would in fact be generic to the Examiner's articulation of claim 25. Therefore, while the Applicant does not concede that the Fourth Office Action's characterizations are accurate, the Applicant respectfully asserts that those same characteristics preclude the restriction of these claims under M.P.E.P. § 806.04(d). As such, the Applicant respectfully requests that that the restriction be withdrawn.

The Applicant thanks the Commissioner for taking the time to review this petition and respectfully requests that this petition be granted 37 C.F.R. § 1.144.

Dated: July 8, 2005

Respectfully submitted,  
By \_\_\_\_\_  
Michael A. Papalas  
Registration No.: 40,381  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-8000  
(214) 855-8200 (Fax)  
Attorney for Applicant